



TRANSCRIPT* OF INTERVIEW 2006 AUGUST 17

Examiner: Hello.

Applicant: Yes, hello, I'm looking for Tri Mai, sir.

Examiner: This is he.

Applicant: Sir, this is Pete Mickelson. I sent you a FAX about two weeks ago asking if we could have an interview on one of the applications you're processing with me.

Examiner: What is your number sir?

Applicant: The serial number is 10/724,653.

(pause)

Examiner: What is it you want to talk about?

Applicant: Well, currently the application is rejected.

Examiner: Yeah.

Applicant: . . . and I'd like to talk about that rejection. I specifically would like to talk about four things which I mentioned in the FAX about two weeks ago. I was hoping to prepare you for it a little that way. In the first paragraph, Claim 12 is rejected.

Examiner: Mm-hmm.

Applicant: There are several reasons that you give here, as I understand it. The first, which I really was confused by, is that it contains subject matter not described in the specification, and therefore this was a new matter rejection.

Examiner: Yes sir.

Applicant: What confused me there was that in the original application and the specification for the patent we talk about a fold line, which is where this wallet folds. And, the way that you have referred to it in this paragraph is that it was not described in the original specification, and that it is not a single fold, and I don't comprehend what problem you and I are having in understanding one another on this.

Examiner: Okay. You're saying that there's a single fold between the layers . . . umm . . . okay . . . Look at the drawings, and in Figure 1 you've got a bunch of layers formed together in the wallet . . .

Applicant: That's correct.

Examiner: . . . and when you fold it, there are several fold lines.

Applicant: No. No. That's my point. The fold line is a construct, similar to the center of a circle, for example. There is one center to twelve concentric circles . . .

Examiner: Mm-hmm.

Applicant: There's still only one center, and in this case there is one fold line. It is shown as item number 11 in Figure 1, and it is the line . . . It is not a physical object that you can hold in your hand -- it is the line about which the wallet is folded, and the only reason that I put that there is that almost every wallet that is constructed -- and this is very normal for wallets -- is that they're folded around that line so that they fit into your pocket. So, I needed that fold line as a reference point for describing . . .

Examiner: So, why don't you just take off the "single"? In the end, you overcome that rejection, because it looks to me like that you have several layers, and that with these several layers the fold is on top of one another, and if you fold it there's going to be three or four fold lines.

Applicant: No. I'm sorry. The fold line is only one place, and all these layers are folded around it. It's true there are several folded layers, but there is only one fold line . . .

Examiner: But don't you think that each layer is having its own fold line?

Applicant: Absolutely no. If you have a series of concentric circles all around one center . . .

Examiner: But now we're not talking about circles. We're talking about fold lines, and that's why . . . you know, if you've got one sheet of material and it's folded, that's one fold line, okay? And if you've got another fold line . . .

Applicant: But it's folded about the same fold line.

Examiner: But, you know, the only way that I can see that you can get around this is to eliminate that "single."

Applicant: But you understand that the word "single" was added . . .

Examiner: Yeah.

Applicant: . . . and the reason was that you've called to our attention the patent by Giard, and Giard talks about a sweatband -- not a wallet, but a sweatband -- which is folded along two -- not one -- but two fold lines.

Examiner: But the wallet itself has two single fold lines.

Applicant: I'm sorry . . . ?

Examiner: You know, if you say like that, there are two single fold lines in that particular reference. A single fold line, like you say, refers to locations.

Applicant: What word could I use that would be clear for both of us that would describe the difference between a wallet like ours with a single fold line, which is typical of wallets -- if you understand what I'm saying -- and the sweatband of Giard which, if you remember, is folded along its length first, so that it can be wrapped around your wrist, and then never appears really as a wallet. It's never suggested to be folded in half. But in order to have it shown like our wallet, it would have to be folded around a second fold line, right above -- let's say -- the number "6" in "Figure 6." That's the only way that Giard could ever appear to look like this wallet. So I'm trying . . . help me here . . . because I'm trying to find ways for you and me to come to a common understanding, with English words, that describes how ours is different from Giard, okay? That's my problem. Do you have Figure 6 of Giard in front of you?

Examiner: Do you know the number?

Applicant: It's 5,671,481.

Examiner: Wait, let me get your name first.

Applicant: My name is Pete Mickelson. The full name is Nils Peter Mickelson.

(pause)

Examiner: The structure looks, you know, pretty much the same . . .

Applicant: I agree, Sir. The picture . . .

Examiner: Look, this looks the same in one continuous arc and fold it into one single fold line and put it in your pocket. .

Applicant: That's true, but if I folded a circle in half, for example, it would be in the shape of a letter "D."

Examiner: I'm looking at Figure 4, and one skilled in the art would fold it in half and put it in the pocket, you know, for a band like that you can support several lines. I understand having the bottom one two fold lines and up around the reverse, but when you want to have this kind of wallet you want to put in your pocket, you would fold it and the fold one line, and two lines, and three lines, and put it in your pocket. It would be obvious.

Applicant: I do appreciate your thoughts, and the only thing is that there is nothing in Giard -- either as a sweatband or in any part of the description -- that would say or suggest that it be used that way. I don't question you, but my understanding is that we're not allowed to read into something that which is not there.

Examiner: Well, you know, you ask me whether that claim can read over it right now, no, I don't think so. And if you're going to talk about a single fold line, it looks like Figure 1 right there. It's folded kind of like on two ends and that there are two fold lines there. And that fold line is having two single fold lines.

Applicant: Are you talking about Giard Figure 1 or our Figure 1?

Examiner: I'm talking about Giard Figure 1.

Applicant: Giard Figure 1, that I'm looking at, looks like a round thing that's wrapped around your wrist.

Examiner: Hold on, let me look at the claim.

(pause)

Examiner: Okay, this is how I'm going to read on that Giard reference: look at Figure number 14, and when you fold it in half, along line 230 for example, then you come up with that Figure 11.

Applicant: But you understand that 230 is not stitched. 230 is a fold line. It's the first fold line and only fold line that Giard suggests. I'm looking at Figure 14, and it has two numbers for the same line, 40 and 230. If you look up at Figure 12, it's the same thing; they have a dash-dot line that goes down to represent where you fold Giard.

Examiner: Uh-huh.

Applicant: That's the first fold line, okay?

Examiner: Yeah.

Applicant: If that were the only fold line, then that would be a single fold line for Giard, and it would come to Figure 6. Do you see Figure 6? Figure 6 is what you'd have in your hands if you folded Giard the first time.

Examiner: Yeah, uh-huh.

Applicant: They never suggest -- because it's a wristband that doesn't get folded after that -- they only suggest that you leave it in this configuration of Figure 6, and then wrap it around your wrist such as Figure 1 or Figure 3.

Examiner: So how is that different from yours?

Applicant: Okay. The edge, which in Giard Figure 6 is called edge number 40, is not a fold line in our wallet. That is our long edge, which is stitched, okay? And Giard cannot be stitched because, as a sweatband, she wants to have it open there, to put her hand inside.

Examiner: But you're not claiming the stitch; you're claiming the single fold line at one end.

Applicant: No. No, I'm sorry. Look at our Figure 2. I guess I have to go back to the original rejection. What happened on the first application was that you saw a similarity between our Figure 2, where the wallet is open . . .

Examiner: Uh-huh.

Applicant: . . . completely unfolded, and stitched. You see the dashed line down at the bottom . . .

Examiner: Uh-huh.

Applicant: . . . stitched around the longest edge and up part of the ends. And what you said was -- and I'm not arguing with you in this sense -- was that that looks just like Figure 6 in Giard.

Examiner: Yeah.

Applicant: Okay. We agree. However, Figure 6 of Giard is already folded. So Figure 6 has no bearing on our Figure 2; it only . . .

Examiner: I'm not rejecting the figure; I'm rejecting the claims. Your claim only recites one fold line, okay?

Applicant: That's correct.

Examiner: And that fold line is the fold line that I'm talking about.

Applicant: But the reason I added that was that in your original rejection you had rejected it as looking like Figure 6 in Giard, except folded around a middle line that Giard does not have.

Examiner: But I can look at the figure differently, you know; and your claim is so broad that it can read on several positions, and that's how I take it.

Applicant: Well, can you help me here a little bit, because I don't see it that way at all, and I don't know exactly how to overcome, I'll say, the combination of rejections that you have here in terms of describing what we have. The original claim, if anything, was a little bit broader, but still I was trying to help by distinguishing it from Giard by pointing out how . . .

Examiner: Sir, you already got some allowed claims. If you want to argue, you file a notice of appeal, and then we can bring it up to the Board of Appeals and Interference, okay? And it looks to me like you argue the drawing from the claim, and if you tell me what claim limitation is not taught by that reference, you know, you file that appeal brief and you tell me exactly what in that claim does not meet with the reference that's your reference.

Applicant: So, what you're saying is that rather than talking it through here, that we would file an appeal?

Examiner: Yeah. Uh-huh, because you're already on the final.

Applicant: Well, I understand that, but I . . .

Examiner: I'm not . . . well you know, the claim is pretty broad, and I can't help you. You know, you already got allowed claims.

Applicant: I know that, but those are much smaller claims, and they only have to do with details of the wallet, and not the shape of the wallet and how it fits in the pocket. This wallet is a complete breakthrough, and it has no similarity to any wallet that we've found anywhere, and we don't understand why this is considered to be such a broad claim because it does not read on these other things. We have a single fold line at one end, okay? And the fold line in Giard is not at any end; it's along the entire longitudinal centerline. It's not the same kind of a fold at all. And if you were to see a similarity between the pictures, which is what you've claimed . . .

Examiner: You know . . . right up in the object and purpose of the invention, they are saying the object of this invention is a sport accessory that combines the function of a sweatband, a towel and a wallet. I really can't understand why you can say the one in Giard is not a wallet.

Applicant: Because it is not a wallet. It's a combined-function thing. One of the functions is to hold things, and she shows in there for example . . .

Examiner: You know, if it says the object of this invention is to combine the functions of a sweatband, a towel and a wallet, it IS a wallet. Now, I don't understand why you cannot call that a wallet.

(pause)

Applicant: Well, I'm at a loss for words. I don't know what to say.

Examiner: You know, you said for the claim being a wallet, and clearly in Giard it says that this is a wallet. And I can't understand why you would say this is not a wallet.

Applicant: Well, may we read Claim number 12 in our patent together? Can I go through that with you in words?

Examiner: Yeah. Um-hmm.

Applicant: Because It's not that I would hate to go to an appeal, but it's an expensive and tedious process, and I'd rather come to a friendly understanding here.

Examiner: But you know, well . . . I can't suggest any language; that isn't allowed.

Applicant: It isn't, I guess, suggesting language. It's just trying to find a common term that means the same thing to you and me. That's . . .

Examiner: I'm sorry. I'm not going to do that.

Applicant: Okay. Well, I see that we have a single fold at one end.

Examiner: Okay.

Applicant: Can you see an end in Giard, for example?

Examiner: Yeah, there's two ends; two far ends.

Applicant: Which are the ends? 60 and 50, or . . . ?

Examiner: Okay, portion 40 is one end, portion 70 is another end, in Figure number 6.

Applicant: But portion 40 is a fold.

Examiner: Oh, well, that's an end; therefore, there are two ends.

Applicant: Okay. And you have two edges adjacent to that single fold line. You're saying that they have a single fold line.

Examiner: Mm-hmm.

Applicant: There are two edges that are adjacent to it, one of which is a shorter edge. Now which of the edges, if there is an edge, in Figure 6 for example . . .

Examiner: The edge formed by 40, and the edge formed by 70. Is that similar to what you have?

Applicant: No, no; those are the ends. We just agreed that those are the ends. So 40 and 70 are the ends. We said there's a fold line at one end, and you said the two ends are 40 and 70, for example, so the fold line would be at 40, yes?

Examiner: Okay, hold on.

Applicant: I'm talking about Giard Figure 6.

(pause)

Examiner: Okay, there's one 40, and if you flip on the other side there's one edge -- the long edge -- at 60, and the shorter edge on one of those shorter flaps, okay?

Applicant: First of all, one end is 40; is that correct?

Examiner: Yeah.

Applicant: Okay, then the end opposite that would be 70, yes?

Examiner: Yep. Um-hmm.

Applicant: Okay. And then you're saying, for example, that 50 and 60 are the edges.

Examiner: Yeah. No. There are a plurality of edges, and there are obtuse angles on one of the pockets; that's another edge of the wallet.

Applicant: Okay, but which of these two ends, 50 and 60, which one is the shorter end . . . or edge, rather? They look the same to me.

Examiner: Well, 60 is one edge, do you understand? If you look at Figure 5, okay, there is a slanted portion of a flap, and that's one edge right there.

Applicant: No. No. That's part of the internal construction; that is not the overall outer . . .

Examiner: That's one edge. You know, there's a plurality of edges on that wallet.

Applicant: We're saying in Claim 12 that it has two edges adjacent to the single fold line; one of those two edges -- one of the said edges -- is a shorter edge, okay. I can't see that either of those could be construed to be shorter. They're the same, in Figure 6 and Figure 5.

Examiner: You know, the edge portion 60 is longer because it's curved, right? And you said before there are only two edges that are adjacent the fold line, and you can see the fold line 40 there, and that in Figure number 5, right there, okay, and you can see that in one of the flaps it's got a straight line okay . . .

Applicant: That's not numbered in Figure 5?

Examiner: It's not numbered in Figure 5, but right adjacent to number 90 in Figure 5.

Applicant: I see that. That's a pocket inside the wallet, yes.

Examiner: But that's an edge . . .

Applicant: No. No. No. It's not an edge. I'm sorry, that's . . . what I'm trying to . . . okay, let's agree that if I say, as you are, that that's an edge . . .

Examiner: Yeah.

Applicant: . . . can I put the word "outer edge" in my claim, for example to get away from that? Because I am talking about the extreme edge. You know, I'm trying to describe the patentably different construction of this invention over the prior art, and the prior art does not show, or even lean in the direction of, what we have. And I'm trying to find words which you and I can agree on . . .

Examiner: You are a lawyer. See, I am not a lawyer.

Applicant: I am not a lawyer! Trust me, I am not a lawyer, sir. I am an engineer by trade, and that's all. No, I am not a lawyer. But I'm trying to find ways that we can describe this, and the reason that we replied to the first rejection was to try to understand what you had said, and to meet those with extra words, or whatever it might be, to overcome the objection that you had, and what we came to was first of all a new-disclosure rejection -- which is a whole separate thing to discuss -- but I really was startled by that, because we've always talked about that as a fold line, and suddenly it talks about that as not being incorporated in the original application, and therefore not supported. So that's a 112 rejection, and that's a scary thing to have, to tell you the truth. But what I'm trying to do here is to find words that you and I will both understand, that would be acceptable to you.

Examiner: You claim only a wallet and one single line, two edges. You know, one edge being shorter than the other. That's a very broad claim, and I'm going to decline your offer to make any language on it. Okay? You already got some allowed claims. If you don't take it, I can't help you with that.

(pause)

Applicant: I guess I've never been at this point before; I'm sorry. Umm . . . I do understand that we have some allowed claims, but those . . .

Examiner: Yes. You do have some allowed claims, yes.

Applicant: Yes, absolutely. But those claims are analogous to, for example, Giard's discussion about that diagonal line. You know, the line that . . .

Examiner: Look. You only claim two edges, and you know, you've got . . . any object has got a plurality of edges that you know -- you are an engineer -- you would know. An edge is a very broad term, and anything that you can . . . that straight thing is an edge and you're not excluding any edge being outside or inside the wallet, being the outer periphery of the wallet, or anything like that. You're only claiming two edges, you know, and the claim is still very broad, and the time the office gives us is very finite, and I just don't have time to look at the claims and to offer something else.

Applicant: I very much appreciate that, and I've been there, and I know how that is. The language of the specification which talks about these edges, and shows them with arrows and numbers, shows them . . .

Examiner: But you can't read stuff from the spec into the claims. The claim is very broad.

Applicant: If I put the two "outer edges" would that . . .

Examiner: I'm not going to consider that. You know, if you want to put that, you can file that as the formal submittal to the office, and then I'll take a look at it.

Applicant: Okay. So, the big problem here is the description of those edges; that they need to be clearly defined as outer edges.

Examiner: I'm not going to say anything, okay? And if you want to say "outer edge," fine. I'll take a look at it to see what it looks like, and then we'll consider that.

Applicant: Okay,

Examiner: So, you are a former examiner, and you understand that right?

Applicant: No, I've been to the patent office and worked with an examiner on an interview like this face-to-face, and I know how pressed you are. That's all I'm saying. I'm very well aware of the fact that you're short-handed . . .

Examiner: See, normally, we don't grant interviews after final.

Applicant: No? Well, I didn't know that. But that's another story.

Examiner: All right? Because we only have a finite amount of time to work on these cases.

Applicant: So, you would prefer if I called you before the final.

Examiner: Yeah. Um-hmm. Well, you know, I'm not going to say. Sometimes the claim is broad and it's your job as the attorney or the patent agent to file the language. But you know, if we're going to see something patentable, we would suggest; but once the claim is broad, it's not like we must suggest something to the applicant.

Applicant: No, no, no. I don't mean that you must. I'm trying to do this in a cooperative, collaborative way here, because, you know, to me, where I was raised and the way I am, the edge the way it's shown in the drawing . . . is clear that it's an outer edge, and what you are saying from your perspective is that it could be ANY edge. And I don't disagree with you. That's undoubtedly true, so I would have to be more clear in what I say about that edge. Okay? That's all I'm trying to do, here, is to come to a common understanding with you on what we're talking about.

Examiner: The only way that you can do this is that you put that broad claim as an independent, right? And then you file three or four claims independent on that to clarify that particular edge, and then, you know, I look at the several options that you have and, you know, if there's an edge that comes out that's say patentable over it, then that claim is allowed, and there you've got a better defined edge in the allowed claims.

Applicant: Okay, that's what I would normally do, but I really wanted to talk to you before doing that to find out if I really understood you well, okay?

Examiner: Yeah. Um-hmm

Applicant: That's the thing. And there are a few other questions, if you have . . . well, I know you don't have a minute, but there was another patent called Wieland, and I need to find it in order to tell you the number . . . it's an early one: 601,922.

Examiner: Yeah. Okay.

Applicant: And in the front picture, for example Figure 1, they show that in kind of the same configuration as our Figure 1. Do you understand? In other words, there are two fold lines here . . .

Examiner: Uh-huh.

Applicant: . . . because he's using this as an advertisement gadget. So he's not stitching; he's just like Giard in this sense. He has a fold line down the long . . . long axis, which I don't really see that he has a number for here, but let's say that, in Figure 2, it's the one that goes down the left side and then over the right side. And once you fold that in half, then you fold it again at a fold line which we could say is the bottom of Figure 1.

Examiner: Um-hmm.

Applicant: Okay, now . . . again, this has two fold lines, and I was trying to get away from that by saying "single fold line."

Examiner: But the thing is that you're claiming a fold line having a bunch of layers folded, and if you're looking at it, it's the same thing as what you have. You've got a bunch of layers, and once you fold it like that, you've got a bunch of layers with a single fold line. That means that your definition of a single fold line is just fold once, and if you . . . it depends on the configuration, you can fold once.

Applicant: Can I . . . I'm just trying to find, you know, a different word from "single" maybe, that means that it has only one fold line? You know? I don't know how to express that. "Only one line about which the wallet is folded?"

Examiner: You've got three layers together, and forms at a single fold line, right?

Applicant: Right.

Examiner: And then this one's got two layers, that forms one single fold line right there.

Applicant: Mm-hmm.

Examiner: Right. And then you tell me that this one does not meet the single fold line.

Applicant: I'm saying that this one has two fold lines.

Examiner: But, you know, it's the same thing like what you have; you've got three layers with three fold lines. This one's got two layers with one fold line. It's the same thing. Once you fold after Figure number 2, A and B together, right? And after that you've got one fold line when you fold it again. It's like basically you've got two layers, and you have one fold line after that folding it in half.

Applicant: Mm-mmm.

Examiner: You see how broad your claim is? Can you see why I'm hesitating to help you out, because your claim is so broad that it can read on this four-folded leaf, your pocket book. And a pocket book is well known as a wallet. You know, you can put in a wallet. You can put the stuff between a leaf and then you form two pockets

Applicant: I'm not disagreeing with you that Wieland's concept could also be called a wallet, and I think that that's a question of one century's difference, you know, between when his time was and our time is.

Examiner: But you know, your single fold line is the same thing as this when you fold it half way, you know, and then you got half way and then you got two layers of fold and then you fold it one more time. That's one fold line.

Applicant: Can I say, for example, that ours is folded once? Do you think that that would be a good description? Because in Wieland, it's folded two times, it's folded . . .

Examiner: I can't give you a definite answer. I have to look at it and think about it, and I really can't on the phone. And then I give you an answer, and then let's say you go and put in your summary that the examiner indicated it's allowable. That's happened to me several times and . . .

Applicant: No, no, that's . . . Anyway, I've had some interviews where we, in fact, can reach that agreement, if you will, and I'm sorry if I'm . . .

Examiner: But, you've got a very broad claim, you know, you've got a very broad claim that can read on this four-leaf thing.

Applicant: I don't think that a broad claim . . . A broad claim is not something bad; it's . . . A broad claim when you have a broad invention is appropriate.

Examiner: But it reads on this, and you know that's a broad claim.

Applicant: No, no, no, no. That's . . .

Examiner: It says that you have two folds, all you have is a single line, you know, a fold line and two edges, and one edge being longer than the other. That's a very broad claim. I can't understand. You know, I understand that you fight for your client . . .

Applicant: Well, we have to. That's my job, you know.

Examiner: And so my job is to protect my job, too, and if somebody looked at it, and it's got a mistake like that and you caught it, I get fired.

Applicant: THAT I don't want to have happen. No. That certainly is not the point.

Examiner: You know, the office is very keen now on firing examiners, you know, and I can't have that happen to me.

Applicant: Oh! I haven't heard that one.

Examiner: Yeah.

Applicant: Sir, thank you for sharing that with me. Oh. Well, okay. I don't want to put you in that position. Not at all.

Examiner: You know, it's writ on it, and if I can't make a rejection, I can't, I can't . . . you know? I'm in big trouble.

Applicant: Mmm. Mmm. Mmm. Well, okay; that I don't want. That was not why I called. I'm sorry. Okay. Well, what I will do then is respond to this, and try to put it in condition for appeal. How's that?

Examiner: That's fine.

Applicant: That's the only thing that we can do under the circumstances.

Examiner: Yeah, okay.

Applicant: Thanks you so much for your time.

Examiner: Thank you.

Applicant: Bye.

***Note:** Applicant and examiner have each learned English in different parts of the world. Applicant may therefor have misunderstood Examiner's exact word from time to time. If that has happened, please excuse the error.

Date: 3 August 2006

To: GAU 3727 - Tri M. Mai, Examiner 571-272-4541 (FAX 571-273-8300)

From: Nils Peter Mickelson, Reg. Nr. 40,089 207-929-4840 (FAX 207-929-4165)

Subject: Request for Telephone Interview, Application 10/724,653

Dear Examiner Mai,

Please let me know a convenient time when we can discuss the Final Office Action mailed 6 June 2006. I can be available all of today, tomorrow before noon, and much of next week.

Points I would like to discuss and clarify are (with reference to the OA paragraph numbers):

1. New-matter rejection; the concept and meaning of a "fold line"; the manner in which Giard is folded; the meaning of "portion 11."
2. The terms "shorter edge."
3. The manner in which Wieland is folded and shaped
4. The relationship between the present invention and Gomi, Christiansen and Giard.

Thank you.

Respectfully,

Nils Peter Mickelson